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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,025	09/15/2003	Jean-Baptiste Dumas Milne Edwards	G-077US03DIV	2603

23557 7590 06/14/2006

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EXAMINER

MARTINELL, JAMES

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/664,025	Applicant(s) EDWARDS ET AL.	
	Examiner James Martinell	Art Unit 1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-50, 52-55, 59-62 and 66-73 is/are rejected.
- 7) ☒ Claim(s) 51, 56-58 and 63-65 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/5/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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Applicants have elected to prosecute the invention of Group I (corresponding to originally filed claims 1, 3-21, 23-31, and 41-46) and have selected SEQ ID NO: 43 which encodes SEQ ID NO: 3903) Election was made **without** traverse in the reply filed on April 17, 2006. In the response filed April 17, 2006 claims 1-46 were cancelled and new claims 47-73 were filed. Claims 47-73 are examined.

The disclosure is objected to because of the following informalities.

- (a) At page 161, line 5, "125 a-c" should be changed to "125 A-C" to match Figure 6.

Appropriate correction is required.

The drawings are objected to for the following reasons.

- (a) Nucleic acid sequences without identifying SEQ ID NOs appear in Figure 5. The Sequence Rules (37 CFR §§ 1.821-1.825), particularly 37 CFR § 1.821(d) and MPEP 2422. In order for any response to this office action to be considered to be a complete response, correction of this matter is required.
- (b) Numerals 270 and 278 in Figure 8 are not discussed in the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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Claim 57 objected to because of the following informalities.

- (a) In claim 57, "comprises comprising" should be changed to "comprises".

Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49, 50, and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are incomplete.

- (a) The recitation of "said polypeptide" (claims 49 and 50) is incomplete because there is no antecedent basis for the term.
- (b) The recitation of "said signal sequence" (claim 52) is incomplete because there is no antecedent basis for the term.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 47 and 48 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by GenBank® Accession No. AI138881 (October 28, 1998). GenBank® Accession No. AI138881 discloses a nucleic acid that comprises SEQ ID NO: 43, nucleotides 53-103 which nucleic acid also encodes SEQ ID NO: 3903, amino acids -17 to -1. Thus, the claims embrace the nucleic acids of GenBank® Accession No. AI138881. See the alignments below.

```

RESULT 1
AI138881/c
LOCUS      AI138881                331 bp    mRNA    linear    EST 28-OCT-1998
DEFINITION qd99c04.x1 Soares_testis_NHT Homo sapiens cDNA clone IMAGE:1737606
            3', mRNA sequence.
ACCESSION  AI138881
VERSION    AI138881.1  GI:3644853
KEYWORDS   EST.
SOURCE     Homo sapiens (human)
ORGANISM   Homo sapiens
            Eukaryota; Metazoa; Chordata; Craniata; Vertebrata; Euteleostomi;
            Mammalia; Eutheria; Euarchontoglires; Primates; Catarrhini;
            Hominidae; Homo.
REFERENCE  1 (bases 1 to 331)
AUTHORS   NCI-CGAP http://www.ncbi.nlm.nih.gov/ncicgap.
TITLE     National Cancer Institute, Cancer Genome Anatomy Project (CGAP),
            Tumor Gene Index
JOURNAL    Unpublished (1997)
COMMENT    Contact: Robert Strausberg, Ph.D.
            Email: cgapbs-r@mail.nih.gov
            cDNA Library Preparation: M. Bento Soares, Ph.D., M. Fatima
            Bonaldo, Ph.D.
            cDNA Library Arrayed by: Greg Lennon, Ph.D.
            DNA Sequencing by: Washington University Genome Sequencing Center
            Clone distribution: NCI-CGAP clone distribution information can be
            found through the I.M.A.G.E. Consortium/LLNL at:
            www-bio.llnl.gov/bbrp/image/image.html
            Insert Length: 395 Std Error: 0.00
            Seq primer: -40m13 fwd. ET from Amersham.

FEATURES             Location/Qualifiers
     source            1..331
                       /organism="Homo sapiens"
                       /mol_type="mRNA"
                       /db_xref="taxon:9606"
                       /clone="IMAGE:1737606"
                       /sex="male"
                       /lab_host="DH10B"
                       /clone_lib="Soares_testis_NHT"
                       /note="Vector: pT7T3D-Pac (Pharmacia) with a modified
                       polylinker; Site_1: Not I; Site_2: Eco RI; 1st strand cDNA
                       was prepared from mRNA obtained from Clontech
                       Laboratories, Inc., and primed with a Not I - oligo(dT)
                       primer [5'
                       TGTTACCAATCTGAAGTGGGAGCGGCCGCCCAATTTTTTTTTTTTTTTT 3'].
                       Double-stranded cDNA was ligated to Eco RI adaptors
                       (Pharmacia), digested with Not I and cloned into the Not I

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and Eco RI sites of the modified pT7T3 vector. Library went through one round of normalization to Cot5, and was constructed by Bento Soares and M. Fatima Bonaldo. "

ORIGIN

Alignment Scores:

Pred. No.:	0.000432	Length:	331
Score:	81.00	Matches:	17
Percent Similarity:	100.0%	Conservative:	0
Best Local Similarity:	100.0%	Mismatches:	0
Query Match:	100.0%	Indels:	0
DB:	1	Gaps:	0

US-10-664-025-3903_COPY_1_17 (1-17) x AI138881 (1-331)

Qy 1 MetAlaLeuGluValLeuMetLeuLeuAlaValLeuIleTrpThrGlyAla 17
 |||||
 Db 331 ATGGCGTTAGAAGTCTTGATGCTCCTCGCTGTCTTGATTGGACCGGTGCT 281

RESULT 1

AI138881/c

LOCUS AI138881 331 bp mRNA linear EST 28-OCT-1998

DEFINITION qd99c04.x1 Soares_testis_NHT Homo sapiens cDNA clone IMAGE:1737606 3', mRNA sequence.

ACCESSION AI138881

VERSION AI138881.1 GI:3644853

KEYWORDS EST.

SOURCE Homo sapiens (human)

ORGANISM Homo sapiens

Eukaryota; Metazoa; Chordata; Craniata; Vertebrata; Euteleostomi;
 Mammalia; Eutheria; Euarchontoglires; Primates; Catarrhini;
 Hominidae; Homo.

REFERENCE 1 (bases 1 to 331)

AUTHORS NCI-CGAP <http://www.ncbi.nlm.nih.gov/ncicgap>.

TITLE National Cancer Institute, Cancer Genome Anatomy Project (CGAP), Tumor Gene Index

JOURNAL Unpublished (1997)

COMMENT Contact: Robert Strausberg, Ph.D.

Email: cgapbs-r@mail.nih.gov

cDNA Library Preparation: M. Bento Soares, Ph.D., M. Fatima Bonaldo, Ph.D.

cDNA Library Arrayed by: Greg Lennon, Ph.D.

DNA Sequencing by: Washington University Genome Sequencing Center

Clone distribution: NCI-CGAP clone distribution information can be found through the I.M.A.G.E. Consortium/LLNL at:

www-bio.llnl.gov/bbrp/image/image.html

Insert Length: 395 Std Error: 0.00

Seq primer: -40ml3 fwd. ET from Amersham.

FEATURES

source

Location/Qualifiers

1..331

/organism="Homo sapiens"

/mol_type="mRNA"

/db_xref="taxon:9606"

/clone="IMAGE:1737606"

/sex="male"

/lab_host="DH10B"

/clone_lib="Soares_testis_NHT"

/note="Vector: pT7T3D-Pac (Pharmacia) with a modified polylinker; Site_1: Not I; Site_2: Eco RI; 1st strand cDNA was prepared from mRNA obtained from Clontech Laboratories, Inc., and primed with a Not I - oligo(dT) primer [5' TGTTACCAATCTGAAGTGGGAGCGGCCGCCCAATTTTTTTTTTTTTTTTTT 3']. Double-stranded cDNA was ligated to Eco RI adaptors (Pharmacia), digested with Not I and cloned into the Not I and Eco RI sites of the modified pT7T3 vector. Library went through one round of normalization to Cot5, and was constructed by Bento Soares and M. Fatima Bonaldo. "

Query Match 100.0%; Score 51; DB 1; Length 331;
Best Local Similarity 100.0%; Pred. No. 2.4e-08;
Matches 51; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

Claims 47, 48, 53-55, 59-62, and 66-73 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ruben et al (U.S. Patent Application Publication 20030050442A1). Ruben et al discloses a nucleic acid that comprises SEQ ID NO: 43, nucleotides 53-103 which nucleic acid also encodes SEQ ID NO: 3903, amino acids -17 to -1. See the alignments below. SEQ ID NOs: 27 and 113 of Ruben et al correspond to Gene No. 17 in Ruben et al (see paragraphs 0158-0162). The reference further discloses the use of expression vectors and production of the secreted protein (*e.g.*, see the Abstract and paragraphs 0001-0007). SEQ ID NOs: 27 and 113 and Gene No; 17 of Ruben et al (U.S. Patent Application Publication 20030050442A1) find support in Serial No. 60/130,991 (filed April 26, 1999) relied upon by Ruben et al (U.S. Patent Application Publication 20030050442A1) in SEQ ID NOs: 22 and 53 and Gene No: 12, respectively.

RESULT 10
US-10-050-704-27
; Sequence 27, Application US/10050704
; Publication No. US20030050442A1
; GENERAL INFORMATION:
; APPLICANT: Ruben et al.
; TITLE OF INVENTION: 62 Human Secreted Proteins
; FILE REFERENCE: PZ039P1
; CURRENT APPLICATION NUMBER: US/10/050,704
; CURRENT FILING DATE: 2002-01-18
; PRIOR APPLICATION NUMBER: 09/684,524

```

; Sequence 27, Application US/10050704
; Publication No. US20030050442A1
; GENERAL INFORMATION:
; APPLICANT: Ruben et al.
; TITLE OF INVENTION: 62 Human Secreted Proteins
; FILE REFERENCE: PZ039P1
; CURRENT APPLICATION NUMBER: US/10/050,704
; CURRENT FILING DATE: 2002-01-18
; PRIOR APPLICATION NUMBER: 09/684,524
; PRIOR FILING DATE: 2000-10-10
; PRIOR APPLICATION NUMBER: PCT/US00/08979
; PRIOR FILING DATE: 2000-04-06
; PRIOR APPLICATION NUMBER: 60/128,693
; PRIOR FILING DATE: 1999-04-09
; PRIOR APPLICATION NUMBER: 60/130,991
; PRIOR FILING DATE: 1999-04-26
; NUMBER OF SEQ ID NOS: 344
; SOFTWARE: PatentIn Ver. 2.0

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```
; SEQ ID NO 27
; LENGTH: 1898
; TYPE: DNA
; ORGANISM: Homo sapiens
; FEATURE:
; NAME/KEY: SITE
; LOCATION: (1398)
; OTHER INFORMATION: n equals a,t,g, or c
; NAME/KEY: SITE
; LOCATION: (1428)
; OTHER INFORMATION: n equals a,t,g, or c
US-10-050-704-27
```

```
Query.Match          100.0%; Score 51; DB 5; Length 1898;
Best Local Similarity 100.0%; Pred. No. 3.7e-10;
Matches 51; Conservative 0; Mismatches 0; Indels 0; Gaps 0;
```

```
Qy      1 ATGGCGTTAGAAGTCTTGATGCTCCTCGCTGTCTTGATTGGACCGGTGCT 51
          ||||||||||||||||||||||||||||||||||||||||||||
Db      15 ATGGCGTTAGAAGTCTTGATGCTCCTCGCTGTCTTGATTGGACCGGTGCT 65
```

Claims 51, 56-58, and 63-65 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719.

The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735.

OFFICIAL FAX NUMBER


The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any Official Communication to the USPTO should be faxed to this number.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.


James Martinell, Ph.D.
Primary Examiner
Art Unit 1634

5/31/06